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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,429	02/07/2002	Jacques Fagot	1759.071	2615

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/17/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/072,429

Applicant(s)

FAGOT, JACQUES

Examin r

Stephen L. Blau

Art Unit

3711

-- Th MAILING DATE of this communication appears on the cov r sh et with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,9,10,13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 4 . 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 3-4, 6, 9-10 and 13-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one of a volume and a position of said at least one recess inside said upper wall varies in distance relative to said upper face in claim 1 must be shown or the feature(s) canceled from the claim(s). The distance to the upper face appears to stay the same in figures 8a, 8b, and 8c. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 5, 7-8, and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is indefinite in that it is uncertain of the meaning of the statement, "in that the at least one of a volume and a position of said at least one recess inside said upper wall varies in distance relative to said upper face". Claim 7 is indefinite in that the terms "such as" are indefinite. Claims 2, 5, 8, and 11-12 are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 5, 8, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Besnard.

Peters discloses a set of club irons each iron of a set having a head, a head having a rear face, a rear face having a cavity bounded by a plurality of walls, wherein a plurality of walls comprises at least one lower wall forming a sole and an upper wall, an upper wall having a plurality of faces, a plurality of faces comprises a rear face, an upper face (Figs. 20-22), a lower face facing the cavity and a plurality of lateral faces, at least one recess in the lower wall in the form of where weight inserts attached (Ref. Nos. 174, 176, 178), a recess being elongated in a main direction of a lower wall (Ref. Nos. 174, 176, 178) at least one recess opens onto a rear face of a lower wall, away from the upper and lower faces of the lower wall, wherein at least one of volume and a position of said at least one recess inside a lower wall varies in distance relative to an upper face from one iron to another, a volume of all the recesses changing, number of recesses changing (Figs. 20, 22), a recess being a small amount compared to the volume of a head (Figs. 20, 22), a set having a center of gravity varying in distance relative to an upper face of an upper wall from one iron to another, and a center of gravity increasing in height from long irons to short irons (Figs. 30-31). Peters does not specifically state that adding additional recesses or additional volume of recesses with weight inserts as shown between figures 20 and 22 would change the center of gravity but clearly an artisan skilled in forming a set of irons with different center of gravities as shown in figures 30-31 would have selected a suitable way to adjust weight distribution in the vertical direction in which using addition recesses of the same volume with weight inserts between irons in a set are included.

Peters lacks at least one recess in the upper wall and said at least one recess opens onto a single face of an upper wall, away from the upper and lower faces, recess being elongated in a main direction of an upper wall, a volume of the recess being between .4 and 5 % of the volume of the head, at least one of volume and a position of said at least one recess inside an upper wall varies in distance relative to an upper face from one iron to another within a set causing a gravity of each head to vary in distance relative to an upper face from one iron to another, and the number of recesses or volume of recesses decreasing from long irons to short irons.

It would have been obvious to modify the set of irons of Peters to have at least one of volume and a position of said at least one recess inside a lower wall varies in distance relative to an upper face from one iron to another within a set to cause a center of gravity of each head to vary in distance relative to an upper face of an upper wall from one iron to another and the number of recesses or volume changing from long irons to short irons in order to have weights added more protected by being in an insert compared to being attached to a sole as shown in figure 3 of Peters.

Besnard discloses at least one recess in the upper wall and said at least one recess opens onto a single face of an upper wall, away from the upper and lower faces, an recess being elongated in a main direction of an upper wall, and a volume of the recesses compared to a head (Figs. 9-10, 12) in order to position the center of gravity lower (Col. 2, Lns. 37-36). Besnard does not specifically disclose the volume of the recesses compared to a head volume but clearly an artisan skilled in forming a head with a low center of gravity using recesses in an upper wall would have selected a

Art Unit: 3711

suitable volume for the recesses in which a volume of the recess being between .4 and 5 % of the volume of the head is included. In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have at least one recess in the upper wall instead of the lower wall and said at least one recess opens onto a single face of an upper wall, away from the upper and lower faces, a recess being elongated in a main direction of an upper wall and wherein at least one of volume and a position of said at least one recess inside an upper wall varies in distance relative to an upper face from one iron to another within a set causing a gravity of each head to vary in distance relative to an upper face from one iron to another and the number of recesses or volume of recesses decreasing from long irons to short irons in order to simplify the assembly process by having fewer parts (i.e. no weight inserts). In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have a volume of the recess being between .4 and 5 % of the volume of the head in order to have a sufficient amount of weight removed from a top of a head to lower the center of gravity a sufficient distance.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Besnard as applied to claims 1-2, 5, 8, and 11-12 above, and further in view of JP 07213656 and Fenton.

Peters lacks the recess being filled with a low-density material of polyurethane foam. JP 072113656 discloses mounting impact absorbing material on a top edge of a back of an iron to improve feeling (Abstract, Constitution). Fenton discloses an impact

Art Unit: 3711

absorbing material placed in a recess on a back of an iron being polyurethane (Abstract) in order to have a softness and elasticity to create a substantial lessening of vibration while still having a toughness to prevent abrasion from scratching with resultant damage to clubs (Col. 1, Lns. 24-40). In view of the reference of JP 072113656 it would have been obvious to have the recess being filled with a low-density material in order to improve feeling by absorbing vibrations. In view of the reference of Fenton it would have been obvious to have the recess being filled with polyurethane material in order to have a softness and elasticity to create a substantial lessening of vibration while still having a toughness to prevent abrasion from scratching with resultant damage to clubs.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Slb 15 March 2003


STEPHEN BLAU
PRIMARY EXAMINER